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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,875	04/19/1999	HUBERT MANHES	02581P0045A	8095

7590 10/23/2002

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[REDACTED] EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/214,875	MANHES, HUBERT
	Examiner	Art Unit
	Vy Q. Bui	3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on May 9, 2002 (amendment G).

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 24-31 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 24-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 07 February 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 07 February 2000 is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Regarding claims 24-31, the phrase "or the like" (line 3, independent claim 24 and line 3 and independent claim 30) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
2. Claim 24 recites the limitation "the body wall" (see the last line of the claim). There is insufficient antecedent basis for this limitation in the claim.
3. Claim <sup>26</sup>~~24~~ recites the limitation "the surgery instrument" (line 3 of the claim). There is insufficient antecedent basis for this limitation in the claim.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "flange displaceable along the distal section of the elongate part" as recited in claim 31 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

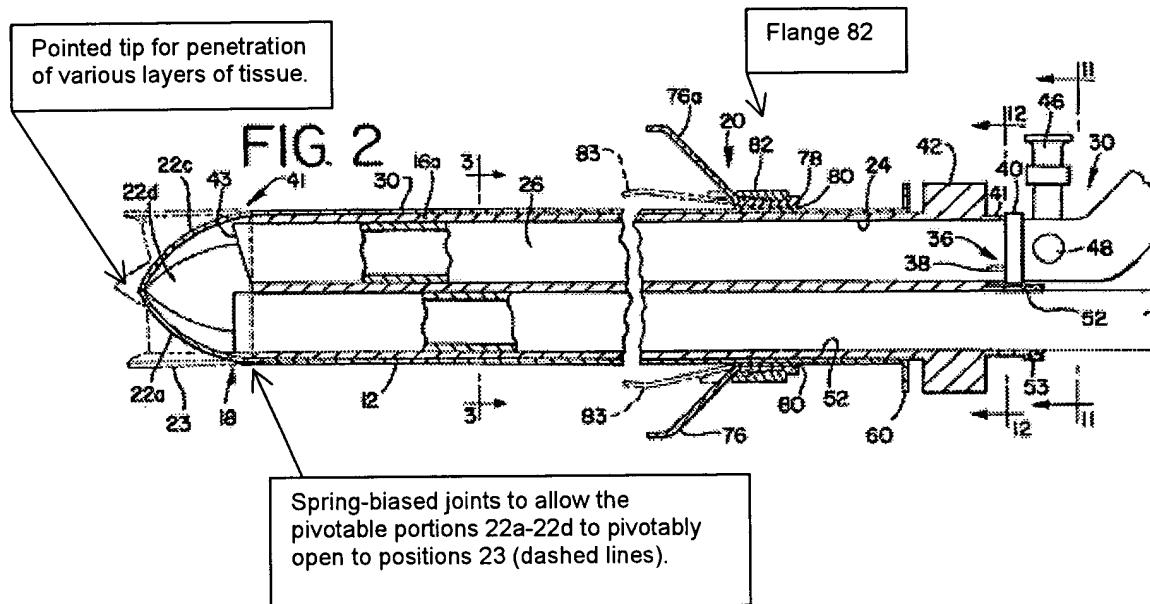
The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 24 and 28-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KO (5,354,302).

As to claims 24-25 and 28-29, KO (Fig. 2, 7-10) discloses a trocar sleeve 10 comprising an elongate part 12 having a passage for insertion of an instrument such as a visual observation device 26 (as clearly shown in Fig. 5 and 10). The trocar sleeve 10 comprises pivotable parts/wings/wedges 22a-22d (Fig. 1, 2 and 9; line 63, column 7 to line 6, column 8) each having a blade end portion and spring-biased joints (see Fig. 2 shown below). The pivotable parts converge toward one another to form a **conical penetration tip** 18 in a piercing position (Fig. 1, 2 and 6) for penetration various layers of body tissue (lines 37-45, column 8). Notice that KO refers conical penetration tip 18 as blunt tip because of the overall rounded conical shape of the penetration tip 18, however, from Fig. 2 and 9, the pivotable parts/wings/wedges 22a-22d do form a pointed tip which permit penetration of various layers of body tissue.

Alternatively, it would have been obvious to one of ordinary skill in the art to modify penetration tip 18 having a overall rounded conical shape (or blunt tip) to a regular conical shape (pointed tip) for penetration of a body tissue, as this modification is just a minor modification of the penetration tip 18 in shape and size and this modification does not make any critical difference in the performance of the KO device.

As to claims 30-31, KO (Fig. 6-8) discloses flange 82 bearing against an outer side of a body wall and displaceable along the distal section of the elongate part 12.



### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over KO (5,354,302) in view of SORENSEN et al (5,320,627).

As to claims 26-27, KO discloses substantially all structural limitations as recited in the claims including the pivotable parts/wings/wedges 22a-22d bearing against an inner side of the body wall (Fig. 8-9), except for the spring-biased joints biasing the pivotable parts/wings/wedges 22a-22d away from one another to an operative position

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upon displacement of an instrument along the passage. However, SORENSEN (Fig. 17-19; lines 12-53, column 13) discloses springs 108a-108d biasing pivotable parts 106a-106d away from one another to an operative position upon displacement of an elongate cutting tool 142 (Fig. 16) along a passage/lumen of trocar 103. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide KO device with a spring-biased joints as taught by SORENSEN, as this configuration would provide spring-biased joints to bias the pivotable parts 22a-22d away from one another in an operative position.

### ***Response to Arguments***

Applicant's arguments with respect to claim 24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



VQB

10/18/02.